

REMARKS

Reconsideration of the above application is respectfully requested.

By this amendment the Applicant has made appropriate changes to the specification, drawings and claims. In accordance with the Examiner's observation, paragraph [0000] has been added to the specification in order to properly claim priority to related applications. Furthermore, replacement paragraph [0030] is also provided, having corrected reference numerals commensurate with amended Figure 1, as discussed below. Additionally, Applicant submits herewith a new oath in compliance with 37 C.F.R. 1.67(a) identifying this application by application number and filing date and further correctly identifies residence information of the inventor.

In the drawings, the Examiner has object to the use of the reference numeral "34" in designating the annular passage and an exchange material. Applicants have amended Figure 1 accordingly, wherein reference numeral "35" is substituted for previously utilized reference numeral "34". Submitted herewith are the replacement figures which include the desired changes, without markings, and which comply with 37 C.F.R. § 1.84.

Claims 1-3, 5, 7-10, 13, 15, 18, 21-23, 25, 27-30, 33, 35 and 38 are rejected by the Examiner under 35 U.S.C. 102 (b) as being anticipated by Bischof et al. (5,300, 019). Applicant respectfully traverses these rejections.

The Examiner has noted that Bischof et al. teaches the irradiation through a wall of one of the two members. However, all independent claims (1, 21 and 41) of the present invention have been amended to recite the limitation of processing energy that passes "at least one window in a wall of the two members". This is unlike the teachings and disclosure of Bischoff et al. where there is absolutely no mention of a window in any portion of the apparatus, but rather, an outer wall "is essentially transparent to the radiation within a prescribed wavelength" (Col. 2 lines 9-10) and "...housing wall 22 is made from a material that is essentially transparent to the radiationshown by the arrow labeled with the letter R in FIGS 4 and 5)." (Col. 4 lines 59-63).

Hence, in the absence of any teaching or suggestion in the Bischof et al. reference of “at least one window in a wall of the two members” through which processing energy is radiated, anticipation of the present invention is negated. This is because all elements of the claimed invention must be disclosed in a single reference for anticipation to exist. Atlas Powder Co. v. E. I. DuPont de Nemours & Co., 750 F.2d 1569, 224 U.S.P.Q. 409 (Fed. Cir. 1984). Missing elements cannot be supplied by the knowledge of one skilled in the art or the disclosure of another reference in order to give rise to an anticipation rejection. Structural Rubber Products Co. v. Park Rubber Co., 749 F.2d 707, 223 U.S.P.Q. 1264 (Fed. Cir. 1984). Therefore, there is no anticipation of the present invention, as now claimed, and Applicant respectfully requests the Examiner to withdraw all 35 U.S.C. 102 (b) rejections to the allowable independent claims and all claims that depend there from.

Claims 6, 14, 26 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bischof et al. (5,300,019), and in further view of Holl (5,538,191). Additionally, claims 4, 11, 12, 16, 17, 19, 20, 24, 31, 32, 36, 37, 39, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bischof et al. (5,300,019) in view of applicant’s admitted prior art. Applicant respectfully traverses all 35 U.S.C. 103(a). rejections.

It is clear that 35 U.S.C. §103 requires an analysis of the claimed invention as a **whole**, i.e. an analysis of the claimed combination of elements, including each and every limitation encompassed by the pending dependent claims. Even where the claimed invention is comprised of individual components well known at the time of invention, “[w]hat must be found obvious to defeat the patent **is the claimed combination.**” The Gillette Co. v. S.C. Johnson & Son Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). Thus, the present amended claims and all dependent thereon are allowable.

As discussed above, there is no teaching of processing energy that “...passes “...at least one window in a wall of the two members”, as presently claimed in all of the independent claims. Necessarily, this limitation is incorporated into and is part of dependant claims 6, 14, 26 and 34. As such, and since neither Bischof et al. (5,300,019) or Holl (5,538,191) teach, disclose or suggest any such limitation, these claims are both novel and unobvious based upon the cited art, the axis of rotation recited in claims 6, 14, 26 and 34 being additional limitations to the

allowable claims from which they depend.

Similarly, dependant claims 4, 11, 12, 16, 17, 19, 20, 24, 31, 32, 36, 37, 39, 40 and independent claim 41 all have as a limitation of “...at least one window in a wall of the two members”, which is not taught, disclosed or suggested in Bischof et al. (5,300,019) or Holl (5,538,191), alone or in combination. As stated by the Examiner (Page 4 of the January 16, 2003 Office Action) the cited art does not specify the claimed use of electromagnetic energy and that it Applicant does in fact state that the use of such energy is well known. However, use of electromagnetic energy is a particular aspect of the instant invention, and the cited art does not, as shown in the above discussions, teach or disclose the use of electromagnetic energy as taught by the instant application and as presently claimed.

The Examiner has also stated that the linear velocity, and energy frequency range is considered inherent. However, “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Continental Can Co. USA. Inc. v. Monsanto Co., 948 F.2d 1264, 1268-69, 20 U.S.P.Q. 2d 1746, 1749 (Fed. Cir. 1991) (quoting In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). In short, *there must be factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art.* Ex parte Levy, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Int.’f 1990). The Examiner has failed to show how, factually and technically, the linear velocity and energy frequency range limitations of the pending claims necessarily flow from the teachings of the prior art.


In light of the discussion above, Applicant respectfully requests that the Examiner withdraw all 35 U.S.C. 103(a). rejections.

In view of the above, it is submitted that this application is now in good order for allowance, and such early action is respectfully solicited. Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant’s undersigned attorney.

The Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. **50-2638**.

Respectfully submitted,

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